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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,334	06/19/2001	Sylvain Chemtob	2861-4003	9475
27123	7590	08/24/2004	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			LANDSMAN, ROBERT S	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,334

Applicant(s)

CHEMTOB ET AL.

Examiner

Robert Landsman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/20/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Formal Matters

- A. The Amendment dated 7/20/04 has been entered into the record.
- B. Claims 1-5 and 10 are pending and are the subject of this Office Action.
- C. The Information Disclosure Statement dated 7/20/04 has been entered into the record.
- D. All Statutes under 35 USC not found in this Office Action can be found, cited in full, in a previous Office Action.

2. Specification

- A. The amendment filed 7/20/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: On page 6 of Applicants' response dated 7/20/04, Applicants requested the addition of two paragraphs in the "Summary of Invention" in order to provide summary commensurate in scope with the new claims. However, these paragraphs add language such as "consisting essentially of," "variant," "comprising one or more sequences" and "in which one or more amino acid residues are substituted or deleted." Applicant is required to cancel the new matter in the reply to this Office Action or to point out specifically in the specification or original claims where this support for this subject matter can be found.

3. Claim Rejections - 35 USC § 112, first paragraph – new matter

- A. All rejections under 35 USC 112, first paragraph, have been withdrawn in view of Applicants' amendments to claims 1 and 2 to remove any new matter. However, new rejections under 35 USC 112, first paragraph, appear below.
- B. Claims 1-5 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claim 1 recites the limitation "consisting essentially of." Claim 2 recites "consisting essentially of," "variant" and "in which one or more amino acid residues are substituted or deleted." None of these limitations could be found in the specification or claims as originally filed. Applicants are required to amend the claims to remove these

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limitations, or to point out exactly where in the specification support for these limitations can be found.

This is a new matter rejection. Claims 3-5 and 10 are rejected since they depend from claim 1.

4. Claim Rejections - 35 USC § 112, first paragraph – scope of enablement

A. No rejection regarding the scope of enablement is being made under 35 USC 112, first paragraph, over the phrase “derived from” since this phrase requires that specific amino acids are present in the “derived” antagonist.

5. Claim Rejections - 35 USC § 112, first paragraph – written description

A. No rejection regarding the lack of written description is being made under 35 USC 112, first paragraph, over the phrase “derived from” since this phrase requires that specific amino acids are present in the “derived” antagonist.

6. Claim Rejections - 35 USC § 112, second paragraph

A. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim is confusing since it recites “reduce the occurrence of premature delivery of fetus.” Applicants have used the Examiner’s suggestion. However, it may be clearer to recite, for example, “reducing the [occurrence] chance of premature delivery of a fetus,” or “reducing the occurrence of premature delivery of fetuses in the female population” since, as worded, the claim is implying that a female is regularly delivering premature fetuses. Furthermore, this would encompass females having their first offspring.

7. Claim Rejections - 35 USC § 102

A. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Abramovitz et al. (WO 95/00551 – on the IDS of 6/18/01). This rejection is being reinstated. The claim recites a PGF2 receptor antagonist consisting essentially of SEQ ID NO:1 or 4-11. Abramovitz et al. teach a PGF2 receptor comprising at least SEQ ID NO:1 of the present invention (Sequence Comparison already provided in the Office Action mailed 9/30/03). The phrase “consisting essentially of” has not been defined in the specification and, therefore, is being interpreted as “comprising.” Therefore, the present claims read on the full-length receptor. The use of the full-length PGF2 receptor of Abramovitz would act as an antagonist since the receptor has been expressed in X. oocytes (Figures 3A and B). This protein can also be expressed in mammalian cells (page 8, lines 16-33). Therefore, this receptor would compete with

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any other prostaglandin-binding proteins in this cell. Abramovitz et al. also teach pharmaceutical compositions (the buffers used in Example 7). The artisan would immediately envision the protein in a pharmaceutical composition such as buffer or water.

B. The rejection of claims 1 and 5 under 35 USC 102 as being anticipated by Rehwald et al. has been withdrawn in view of the fact that Rehwald et al. do not disclose the sequence of the mutant F2 receptor. Therefore, no *prima facie* case could be made by the Examiner that the receptor of Rehwald comprised any of the claimed sequences of the present invention.

8. Claim Rejections - 35 USC § 103

A. The rejection of claims 1 and 5 under 35 USC 103 as being anticipated by Lake et al. in view of Rehwald et al. has been withdrawn in view of the fact that Rehwald et al. do not disclose the sequence of the mutant F2 receptor. Furthermore, approximately 75% of the presently claimed sequences are found in the fourth transmembrane domain of the protein of Lake, not in the second extracellular loop. Therefore, it would not have been obvious to the artisan at the time of the present invention to have used these residues as an antagonist since the present invention teaches that only residues of the second extracellular loop can be used.

9. Conclusion

A. No claim is allowable.

Advisory information

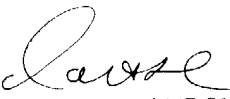
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (571) 272-0888. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Brenda Brumback, can be reached on (571) 272-0961.

Official papers filed by fax should be directed to (703) 872-9306. Fax draft or informal communications with the examiner should be directed to (571) 273-0888.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0700.

Robert Landsman, Ph.D.
Patent Examiner
Group 1600
August 23, 2004


ROBERT LANDSMAN
PATENT EXAMINER